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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/682,121	10/10/2003	Junichi Hara	243887US2	8218

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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EBRAHIMI DEHKORDY, SAEID

ART UNIT	PAPER NUMBER
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2625

NOTIFICATION DATE	DELIVERY MODE
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08/08/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

10/682,121

Applicant(s)

HARA ET AL.

Examiner

Saeid Ebrahimi-dehKordy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Monty et al

(Pub. No.: US 20010019416)

**Regarding claim 1 and 9-11** Monty et al disclose: An image data input/output apparatus (note Fig.8, item 14) comprising: a scanner (Fig.2, item 46, page 3, paragraph 0037, lines 1-7, also note page 2, paragraph 0009, lines 6-8) a printer (note Fig2, item 14 and Fig.8 item 14, also note page 2, paragraph 0009, lines 6-8) a storage unit (note Fig.2, items 28 and 30 the Rom and Ram respectively, page 3, paragraph 0037, lines 14-17, also note page 1, paragraph 0008, lines 22-26) that stores one or more items of image data (note page 3, paragraph 0039) a check sheet (note Fig.8, item 22, which acts as the proof sheet) forming unit that forms a check sheet by compositing thumbnails corresponding to the items of image data stored in said storage unit and causes said printer to print the check sheet (note page 3, paragraph 0032, where the proof sheet or check sheet generated through the firmware programming by include graphical representation of plurality of image selection and/or image enhancement user designated areas, and note page 5, paragraph 0049, where the proof sheet is finally printed by the printer) a selected image recognition unit that causes said scanner to scan the check sheet printed by said printer (note

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page 4, paragraph 0040, where the OCR is used to determined the images or the proof sheet) and recognizes the thumbnails selected by checking the thumbnails composited in the scanned check sheet (note again page 4, paragraph 0040, where the OCR would read the marks set for each thumbnail image designated for each particular thumbnail image) and a selected image output unit that retrieves the items of image data corresponding to the thumbnails selected by checking and outputs the retrieved items of image data (note page 6, paragraph 0055 and page 7, paragraph 0065, where the image selected through the marked section are retrieved and printed, also note Fig.10A steps 266-270).

**Regarding claim 2** Monty et al disclose: The image data input/output apparatus as claimed in claim 1, further comprising an encoding unit that encodes for compressing the items of image data in compliance with JPEG 2000 algorithm, and stores the encoded items of image data in said storage unit (note page 6, paragraph 0058, lines 5-12, where the algorithm is chosen to do the reduction or compression of the size of the images).

**Regarding claim 3** Monty et al disclose: The image data input/output apparatus as claimed in claim 1, wherein said selected image output unit outputs the retrieved items of image data to said printer (note page 7, paragraph 0065, where the image selected through the marked section are retrieved and printed, also note Fig.10A steps 266-270).

**Regarding claim 4** Monty et al disclose: The image data input/output apparatus as claimed in claim 3, wherein said check sheet forming unit forms the check sheet in which a printing condition can be designated (note page 1, paragraph 0008, lines 7-18, and specifically lines 12-16 where the images would included additional information) said selected image recognition unit recognizes the designated printing condition; and said selected image output unit designates the

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printing condition to said printer (note page 3, paragraph 0032).

**Regarding claim 5** Monty et al disclose: The image data input/output apparatus as claimed in claim 1, wherein said selected image output unit outputs the retrieved items of image data to a facsimile apparatus connected to the image data input/output apparatus via a communication interface and a channel (note Abstract, lines 14-16, where the processed images were transmitted to the recipient through either Fax or e-mail)

**Regarding claim 6** Monty et al disclose: The image data input/output apparatus as claimed in claim 5, wherein said check sheet forming unit forms the check sheet in which address information of said facsimile apparatus can be designated; said selected image recognition unit recognizes the designated address information; and said selected image output unit makes a call based on the recognized address information to said facsimile apparatus (note page 4, paragraph 0040, where the OCR would extract the digits in order to send the fax to the recipient).

**Regarding claim 7** Monty et al disclose: The image data input/output apparatus as claimed in claim 1, wherein said selected image output unit outputs the retrieved items of image data to a terminal connected to the image data input/output apparatus via a communication interface and a network (note Fig.8, page 2, paragraph 0018, and page 9&10, paragraph 0083, lines 26-33).

**Regarding claim 8** Monty et al disclose: The image data input/output apparatus as claimed in claim 7, wherein said check sheet forming unit forms the check sheet in which address information of said terminal can be designated; said selected image recognition unit recognizes the designated address information; and said selected image output unit makes a call based on the recognized address information to said terminal (note page 4, paragraph 0040, where the OCR would extract the digits in order to send the fax to the recipient also note that this well

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known in the art as the recipient located in the network has an IP address to used while transferring data over the network).

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim10** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 10 defines a a computer program embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., “When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized” – Guidelines Annex IV). That is, the scope of the presently claimed a computer program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on “computer-readable medium” or equivalent in order to make the claim statutory. Any amendment to the claim should be commensurate with its corresponding disclosure.

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**CONTACT INFORMATION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saeid Ebrahimi-dehKordy whose telephone number is 703-306-3487. The examiner can normally be reached on Mon-Fri, 8:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Saeid Ebrahimi  
Patent Examiner  
Group Art Unit 2625  
August 1, 2007

